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Filing date: **05/06/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

| | |
|------------------------|---|
| Proceeding | 91227377 |
| Party | Plaintiff Yale University |
| Correspondence Address | MARK B HARRISON VENABLE LLP PO BOX 34385 WASHINGTON, DC 20043-9998 UNITED STATES mbharrison@venable.com, trademarkdocket@venable.com |
| Submission | Motion to Amend Pleading/Amended Pleading |
| Filer's Name | Christina M. Licursi |
| Filer's e-mail | cxltrademarks@wolfgreenfield.com, jlwtrademarks@wolfgreenfield.com |
| Signature | /cml/ |
| Date | 05/06/2016 |
| Attachments | 91227377 Amended Notice of Opposition FINAL.pdf(139405 bytes) |

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

| | | |
|-----------------------|---|----------------------------------|
| YALE UNIVERSITY |) | |
| |) | |
| Opposer, |) | |
| |) | Opposition No. 91227377 |
| v. |) | Application Serial No. 86/336817 |
| |) | Mark: OLD YALE BREWING CO. |
| Artisans Ales Limited |) | |
| Partnership |) | |
| |) | |
| Applicant. |) | |
| _____ |) | |

AMENDED NOTICE OF OPPOSITION

Yale University (“Opposer”), a not-for-profit corporation established by charter with the colony and state of Connecticut, with an address at 105 Wall Street, New Haven, Connecticut 06520, believes that it will be damaged by registration of the mark depicted in Application Serial No. 86/336817, filed by Artisans Ales Limited Partnership (“Applicant”) of 435 - 44550 South Sumas Road, Chilliwack, B.C., Canada, V2R0A5, for the mark OLD YALE BREWING CO. for use in connection with “beer” and “operation of a brewery”, which application was published for opposition in the Official Gazette of December 8, 2015, and hereby opposes the same.

The grounds for this Opposition are as follows:

1. Opposer is a world-renowned institution of higher learning, founded in 1701, making it one of the oldest educational institutions in the United States.
2. Opposer was named after Elihu Yale, an early benefactor, and Opposer is often referred to as “Old Eli,” in reference to him.
3. Since at least as early as 1718, Opposer has used the names and trademarks YALE and YALE UNIVERSITY for all types and manner of educational services at the college and graduate school levels.

4. Furthermore, Opposer has also used, or licensed others to use, the mark YALE with a wide variety of goods and services, including catering and hospitality services, restaurant services, and glassware.
5. As a result of the extensive use of the marks YALE and YALE UNIVERSITY, Opposer has achieved widespread fame and recognition for services and goods offered under these marks from a date long prior to Applicant's filing date and/or any first use date.
6. Opposer is the owner of, inter alia, the following U.S. Trademark and Service Mark registrations, printouts of the electronic records of the USPTO of which are attached hereto:

| Mark | Reg. No. | Issue Date | Goods and/or Services |
|-----------------|-----------------|-------------------|---|
| YALE | 2682188 | February 4, 2003 | Class 006: metal keychains Class 009: computer mouse pads Class 012: metal license plate frames Class 014: rings, pendants, earrings, tie tacks, watches, clocks Class 016: decals, calendars, posters, postcards and stationery, notebooks, binders, appointment books, playing cards, pens, pencils, letter openers, paper weights, framed pictures Class 018: tote bags, backpacks, umbrellas, wallets, ID and credit card cases, duffel bags Class 020: designer diploma frames, non-metal key chains and furniture, namely, mirrors Class 021: beverage glassware, mugs, plastic cups and metal wastepaper baskets Class 024: flags, banners and pennants all made of cloth Class 026: ornamental novelty buttons and pins Class 028: stuffed toy animals, golf balls, soccer balls, flying discs, computer game discs, computer game software, Christmas tree ornaments |
| YALE CABARET | 3224341 | April 3, 2007 | Class 041: Entertainment services, namely, presenting live performances by singers or dancers or musicians or story tellers; cabaret services; live cabaret performances Class 043: Restaurant services |
| Yale (stylized) | 3930030 | March 8, 2011 | Class 025: T-shirts; sweatshirts; golf shirts; sweaters; headwear. |
| YALE | 1984951 | July 9, 1996 | Class 025: clothing, namely shirts, suits, headwear, footwear, sweaters, ponchos, rainwear, garters, suspenders, sleepwear, undergarments. |
| YALE | 1391903 | April 29, 1986 | Class 041: Educational services, namely, |

| | | | |
|--|--|--|---|
| | | | providing instruction and training at the undergraduate, graduate, post-graduate, and professional levels; entertainment services, namely, organizing, promoting, and conducting athletic contests and exhibitions, lectures, concerts, and theater productions |
|--|--|--|---|

7. Notwithstanding Opposer’s long and extensive use of the mark YALE for a variety of goods and services, on March 11, 2014, Applicant filed an application to register the mark OLD YALE BREWING CO. for “beer” in Class 32 and for “operation of a brewery” in Class 40, based upon an alleged bona fide intent to use the mark in commerce (“the Old Yale Mark”).
8. On information and belief, Applicant did not use the Old Yale Mark for beer or for operation of a brewery prior to its filing date of March 11, 2014.
9. Applicant’s proposed Old Yale Mark incorporates Opposer's mark YALE in its entirety. The terms OLD and BREWING CO. are merely descriptive and generic, respectively, for Applicant’s goods and services, and so the word YALE is the most prominent and only distinctive component of the Old Yale Mark. Moreover, because Opposer is known to be one of the oldest institutions in the United States and because Opposer is sometimes referred to as “Old Eli,” the use of the adjective OLD to modify YALE in the proposed Old Yale Mark is likely to call to the mind of the consumer, the nickname of Opposer, “Old Eli,” and confuse consumers as to the source of Applicant’s proposed goods and services.
10. The goods and services with which Applicant proposes to use the Old Yale Mark are related to the goods and services with which Opposer has used, or has licensed others to use, the mark YALE. Moreover, it is common practice for university and college names to appear on a wide range of licensed products, which increases the likelihood of confusion between the subject marks.

11. The goods and services for which Applicant seeks to register the Old Yale Mark are likely to be encountered by the same class of purchasers who are customers for the goods and services offered under Opposer's YALE marks.
12. In light of the relatedness of the involved goods and services, consumers are likely to believe that Applicant's goods and services emanate from, or are licensed or approved by Opposer, when that is not the case. Any dissatisfaction with the goods and services of Applicant will reflect upon and irreparably damage the reputation and good will of Opposer as embodied in its YALE marks.
13. Furthermore, there is an enhanced likelihood that consumers will presume a connection between Applicant's proposed goods and services and Opposer. The beverages supplied under the Old Yale Mark could be presumed to be products "licensed" by Opposer. Such beverages may be offered in commerce to the many persons who interact every day with Opposer. Further, Applicant's goods and services could be targeted to Yale University alumni and to Yale University's fans. The goods further could be sold on or adjacent to Yale University's campus. The services likewise could be offered adjacent to or near Yale University's campus. It must therefore be presumed that the market and the channels of trade through which Applicant's applied for goods and services will travel are identical to those in which Opposer's goods and services travel and have travelled since long prior to any date to which Applicant might be entitled.
14. Opposer's fame, reputation, and renown are so extensive that a connection with Opposer and Opposer's goods and services and/or a license from Opposer to use the YALE trademark is likely to be presumed by consumers when the Old Yale Mark is used in connection with Applicant's proposed goods and services.

15. Opposer has endeavored to strictly control how and when the YALE name and mark is associated with alcoholic beverages. In fact, Opposer's license agreements specifically prohibit use of the YALE name and mark in connection with distribution channels whose primary business is the sale of tobacco, alcohol, weapons, political paraphernalia, or any sex-related products.
16. Opposer prohibits underage drinking on its campuses as evidenced by the fact that any drinking under the legal age of 21 is in violation of Opposer's Undergraduate Regulations. As a result, Applicant's use and registration of Opposer's name and mark YALE as a part of a trademark to be used in connection with "beer" and a "brewery" will harm Opposer and cause damage and tarnishment to Opposer's reputation and will undermine Opposer's specific policies governing the use of its trademarks, in that it will cause Opposer's name and mark to be associated with alcoholic beverages and the brewing of alcoholic beverages, in violation of Lanham Act Section 43(c).
17. If Applicant were permitted to use and register the Old Yale Mark for the goods and services specified in its application, confusion among consumers resulting in damage and injury to Opposer and to Opposer's reputation would be caused by virtue of the similarity between the respective marks. Any defect, objection or fault found with Applicant's goods and services would reflect upon Opposer and seriously injure the reputation, value and good will that Opposer has established under its trademarks. Consequently, there exists a likelihood of confusion under Section 2(d).
18. If Applicant is granted registration on the application herein opposed, Applicant would thereby obtain a prima facie exclusive right to use the Old Yale Mark, which would be a further source of damage to Opposer's trademark rights.

WHEREFORE, Opposer prays that Application Serial No. 86/336817 be rejected, that no registration be issued thereon to Applicant, and that this opposition be sustained in favor of the Opposer.

Respectfully submitted,



By _____
Christina M. Licursi
John L. Welch
WOLF, GREENFIELD & SACKS, P.C.
Federal Reserve Plaza
600 Atlantic Avenue
Boston, MA 02210
Tel.: (617) 646-8000
Attorneys for Opposer
Yale University

CERTIFICATE OF SERVICE

The undersigned certifies that the attached Amended Notice of Opposition was served on May 6, 2016, via first class mail, postage prepaid, addressed to Counsel for the Applicant at the address appearing in the electronic records for the Trademark Trial and Appeal Board:

TANYA M. REITZEL
COASTAL TRADEMARK SERV.
1081 CAMBIE STREET
VANCOUVER B.C. V6B5L7,
CANADA
info@coastalip.com



Christina M. Licursi
John L. Welch
WOLF, GREENFIELD & SACKS, P.C.
600 Atlantic Ave.
Federal Reserve Plaza
Boston, MA 02210
Tel.: 617.646.8000
Fax.: 617.646.8646
Attorneys for Opposer
Yale University

Dated: May 6, 2016



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Typed Drawing

Word Mark YALE

Goods and Services IC 006. US 002 012 013 014 023 025 050. G & S: [metal automobile license plates,] metal keychains [, sculptures made of non-precious metal, non-luminous and non-mechanical metal signs]. FIRST USE: 19800101. FIRST USE IN COMMERCE: 19800101

(CANCELLED) IC 008. US 023 028 044. G & S: [pocket knives, cutlery sets consisting of spoons, forks and knives]. FIRST USE: 19950302. FIRST USE IN COMMERCE: 19950302

IC 009. US 021 023 026 036 038. G & S: [computer software screensavers,] computer mouse pads [and computer disk storage boxes and computer disk carriers]. FIRST USE: 19950302. FIRST USE IN COMMERCE: 19950302

(CANCELLED) IC 011. US 013 021 023 031 034. G & S: [lamps] [, lampshades, flashlights]. FIRST USE: 19800101. FIRST USE IN COMMERCE: 19800101

IC 012. US 019 021 023 031 035 044. G & S: metal license plate frames [; automobile hood ornaments not made of precious metal]. FIRST USE: 19950302. FIRST USE IN COMMERCE: 19950302

IC 014. US 002 027 028 050. G & S: rings, [bracelets,] pendants, earrings, tie tacks, watches, clocks [, silver and pewter tankards] [, watch straps; metal trays made of precious metal]. FIRST USE: 18750101. FIRST USE IN COMMERCE: 18750101

IC 016. US 002 005 022 023 029 037 038 050. G & S: decals, [bumper stickers,] calendars, posters, postcards and stationery, [lap desks,] notebooks, binders, appointment books, playing cards, [house mark for a full line of desk accessories, namely, blotters,] [pen and pencil holders,] [paper staplers, adhesive tape dispensers for household or stationery use,] pens, pencils, letter openers, paper weights, [stamp boxes for postage stamps, stamp pads, cardboard boxes for holding waste paper, printed paper signs, bulletin boards, flags, banners and pennants made of paper, tablecloths and napkins made of paper,] framed pictures. FIRST USE: 19500101. FIRST USE IN COMMERCE: 19500101

IC 018. US 001 002 003 022 041. G & S: tote bags, backpacks, [briefcases and] [attache cases,] [all purpose sports bags,] umbrellas, wallets, [luggage,] ID and credit card cases, [garment bags for travel,] [travel bags, gym bags,] duffel bags. FIRST USE: 19800101. FIRST USE IN COMMERCE: 19800101

IC 020. US 002 013 022 025 032 050. G & S: [flags, banners and pennants all made of plastic, soft sculpture wall decorations, metal plaques,] designer diploma frames, non-metal key chains and furniture, namely, mirrors. FIRST USE: 19600101. FIRST USE IN COMMERCE: 19600101

IC 021. US 002 013 023 029 030 033 040 050. G & S: beverage glassware, mugs, [dishes, ice buckets and portable coolers,] plastic cups [and plates, serving trays not of precious metal, metal meal trays] and metal wastepaper baskets. FIRST USE: 19310101. FIRST USE IN COMMERCE: 19310101

IC 024. US 042 050. G & S: flags, banners and pennants all made of cloth [, textile wall hangings]. FIRST USE: 19370101. FIRST USE IN COMMERCE: 19370101

IC 026. US 037 039 040 042 050. G & S: ornamental novelty buttons and pins [and needlepoint kits consisting primarily of needles, thread, needlepoint design pattern and instructions]. FIRST USE: 19950302. FIRST USE IN COMMERCE: 19950302

IC 028. US 022 023 038 050. G & S: stuffed toy animals, [dolls, puppets, kites, board games, balloons,] golf balls, [basketballs and] soccer balls, flying discs, [decorative windsocks, dart games consisting of dart board case, dart board, darts, points, shafts and stems; board games, computer game cassettes,] computer game discs, [computer game joy sticks, computer game programs,] computer game software, [computer game tapes,] Christmas tree ornaments [, golf clubs]. FIRST USE: 19370101. FIRST USE IN COMMERCE: 19370101

Mark
Drawing Code (1) TYPED DRAWING
Serial Number 75977256
Filing Date March 2, 1995
Current Basis 1A
Original Filing Basis 1A
Published for Opposition November 12, 2002
Change In Registration CHANGE IN REGISTRATION HAS OCCURRED
Registration Number 2682188
International Registration Number 0910285
Registration Date February 4, 2003
Owner (REGISTRANT) Yale University NOT-FOR-PROFIT CORPORATION CONNECTICUT 105 Wall Street New Haven CONNECTICUT 06520
Attorney of Record MARK B. HARRISON
Prior Registrations 1391543;1391903;1391926
Description of Mark Color is not claimed as a feature of the mark.
Type of Mark TRADEMARK
Register PRINCIPAL
Affidavit Text SECT 15. PARTIAL SECT 8 (6-YR). PARTIAL SECTION 8(10-YR) 20130326.
Renewal 1ST RENEWAL 20130326
Live/Dead Indicator LIVE

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YALE CABARET

Word Mark YALE CABARET

Goods and Services IC 041. US 100 101 107. G & S: Entertainment services, namely, presenting live performances by singers or dancers or musicians or story tellers; cabaret services; live cabaret performances. FIRST USE: 19680000. FIRST USE IN COMMERCE: 19680000

IC 043. US 100 101. G & S: Restaurant services. FIRST USE: 19680000. FIRST USE IN COMMERCE: 19680000

Standard Characters Claimed

Mark Drawing Code (4) STANDARD CHARACTER MARK

Serial Number 78737802

Filing Date October 21, 2005

Current Basis 1A

Original Filing Basis NO FILING BASIS

Published for Opposition January 16, 2007

Registration Number **3224341**

Registration Date April 3, 2007

Owner (REGISTRANT) Yale University NON-PROFIT CORPORATION CONNECTICUT 105 Wall Street New Haven CONNECTICUT 06520

Attorney of Record MARK HARRISON

Prior Registrations 1391543;2061576;2271288;AND OTHERS

Disclaimer NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "CABARET" APART FROM THE MARK AS SHOWN

Type of Mark SERVICE MARK

Register PRINCIPAL

Affidavit Text SECT 15. SECT 8 (6-YR).

Live/Dead Indicator LIVE

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Yale

| | |
|---------------------------------|---|
| Word Mark | YALE |
| Goods and Services | IC 025. US 022 039. G & S: T-shirts; sweatshirts; golf shirts; sweaters; headwear. FIRST USE: 20080200. FIRST USE IN COMMERCE: 20080200 |
| Mark Drawing Code | (5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM |
| Serial Number | 77981017 |
| Filing Date | April 2, 2009 |
| Current Basis | 1A |
| Original Filing Basis | NO FILING BASIS |
| Published for Opposition | March 2, 2010 |
| Registration Number | 3930030 |
| Registration Date | March 8, 2011 |
| Owner | (REGISTRANT) Yale University non-profit corporation CONNECTICUT 105 Wall Street New Haven CONNECTICUT 06520 |
| Attorney of Record | Mark Harrison |
| Description of Mark | The color(s) blue is/are claimed as a feature of the mark. The mark consists of "YALE" in blue. |
| Type of Mark | TRADEMARK |
| Register | PRINCIPAL |
| Live/Dead Indicator | LIVE |

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| | |
|--|---|
| Word Mark | YALE |
| Goods and Services | IC 025. US 039. G & S: clothing, namely shirts, suits, headwear, footwear, sweaters, ponchos, rainwear, garters, suspenders, sleepwear, undergarments. FIRST USE: 19820000. FIRST USE IN COMMERCE: 19820000 |
| Mark Drawing Code | (1) TYPED DRAWING |
| Serial Number | 74489560 |
| Filing Date | February 14, 1994 |
| Current Basis | 1A |
| Original Filing Basis | 1A |
| Published for Opposition | April 16, 1996 |
| Registration Number | 1984951 |
| International Registration Number | 0910285 |
| Registration Date | July 9, 1996 |
| Owner | (REGISTRANT) Yale University NOT-FOR-PROFIT CORPORATION CONNECTICUT 105 Wall Street New Haven CONNECTICUT 06520 |
| Attorney of Record | MARK B. HARRISON |
| Prior Registrations | 1391543;1391903;1391926 |
| Type of Mark | TRADEMARK |
| Register | PRINCIPAL |
| Affidavit Text | SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20061003. |
| Renewal | 1ST RENEWAL 20061003 |
| Live/Dead Indicator | LIVE |

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| | |
|--|---|
| Word Mark | YALE |
| Goods and Services | IC 041. US 107. G & S: EDUCATIONAL SERVICES, NAMELY PROVIDING INSTRUCTION AND TRAINING AT THE UNDERGRADUATE, GRADUATE, POST-GRADUATE AND PROFESSIONAL LEVELS; ENTERTAINMENT SERVICES, NAMELY ORGANIZING, PROMOTING AND CONDUCTING ATHLETIC CONTESTS AND EXHIBITIONS, LECTURES, CONCERTS AND THEATER PRODUCTIONS. FIRST USE: 17180000. FIRST USE IN COMMERCE: 18140000 |
| Mark Drawing Code | (1) TYPED DRAWING |
| Serial Number | 73412851 |
| Filing Date | February 9, 1983 |
| Current Basis | 1A |
| Original Filing Basis | 1A |
| Published for Opposition | February 4, 1986 |
| Registration Number | 1391903 |
| International Registration Number | 0910285 |
| Registration Date | April 29, 1986 |
| Owner | (REGISTRANT) YALE UNIVERSITY NOT-FOR-PROFIT CORPORATION CONNECTICUT 105 WALL STREET NEW HAVEN CONNECTICUT 06520 |
| Attorney of Record | MARK HARRISON |
| Type of Mark | SERVICE MARK |
| Register | PRINCIPAL |
| Affidavit Text | SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20060806. |
| Renewal | 1ST RENEWAL 20060806 |

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Indicator** LIVE

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